



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/004,511
Applicant : Shannon Morris
Filed : October 22, 2001
TC/A.U. : 3728
Examiner : Luan Kim Bui

Docket No. : OSSV-083441
Customer No. : 30764

#23 / Appeal
Brief
M. WATTS
1/14/04
1/13

APPELLANT'S BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

(1) REAL PARTY IN INTEREST

The real party in interest in this application is the inventor, Shannon Morris.

(2) RELATED APPEALS AND INTERFERENCES

This application is a continuation of application serial No. 08/766,862, now U.S. Patent No. 6,334,530, which was the subject of an appeal to the Board, resulting in a Decision on Appeal mailed September 29, 2000. A copy of the Decision on Appeal is attached hereto as Exhibit A.

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There are no other appeals or interferences known to Appellant or Appellant's legal representative that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

(3) STATUS OF CLAIMS

Claims 1-15 are pending in the application, as set forth in the Appendix hereto. Claims 1-7 and 12-15 are allowed. Claims 8-11 have been finally rejected. Appellant has appealed the rejection of claims 8-11.

(4) STATUS OF AMENDMENTS

There are no pending amendments that have not been entered by the Examiner. Claims 8-11 stand as they were finally rejected by the Examiner.

(5) SUMMARY OF INVENTION

The present invention, as defined by appealed claims 8-11, provides a jewelry organizer for holding jewelry such as rings, earrings, drop earrings, watches, bracelets, necklaces, and other strands of jewelry. It comprises a body having an upper surface and a lower surface and a knob protruding upwardly from the body and extending above the upper surface. The knob has a diameter and height capable of receiving at least one finger ring over the knob, and there is at least one compartment formed in the upper surface of the body for receiving jewelry. The compartment is defined as an elongated channel sized to receive a piece of jewelry.

In a further aspect of the invention, the jewelry organizer may include an outer rim around the periphery of the body with a surface to allow space for jewelry to be displayed thereon. The outer rim may include a lip which is sized to receive a hook of a drop earring thereon.

In addition, the jewelry may further include a recess formed in the lower surface to enable a stackable configuration with a second jewelry organizer having a

knob and at least one compartment. The jewelry organizer may be stacked such that space is maintained between the stacked jewelry organizers to allow jewelry to be placed in the compartment of the second jewelry organizer.

(6) ISSUE

(A) Whether claims 8-11 are unpatentable under 35 U.S.C. § 102 as allegedly anticipated by U.S. Patent No. 5,040,681 to Grusin?

(B) Whether claims 8-11 are unpatentable under 35 U.S.C. § 102 as allegedly anticipated by or obvious over U.S. Patent No. 2,036,572 to Frost?

(7) GROUPING OF CLAIMS

With regard to both issues (A) and (B), claims 8-11 stand or fall together.

(8) ARGUMENT

(A) Claims 8-11 Are Not Anticipated by Grusin

The Examiner has finally rejected claims 8-11 as allegedly anticipated by U.S. Patent No. 5,040,681 to Grusin, asserting that "[t]he knob of Grusin is inherently capable of receiving at least one finger ring over the knob (FIGS. 1-5)." (Office Action mailed 9/2/03, page 2.)

It is fundamental that a claim is anticipated only when the same device, having all of the elements and limitations contained in the claims, is described in a single prior art reference. ATD Corp. v. Lydall, Inc., 159 F.3d 534 (Fed. Cir. 1998) (citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989)). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. Id. (citations omitted).

A reference that does not expressly disclose one or more claimed features can be anticipatory only if the features are inherent in the reference. Continental Can Co.

v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991). However, evidence of inherency "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Id. at 1268 (emphasis added).

An invention is not inherent simply because the obtained result possibly could occur. Rather, an inherent invention is embodied in a single prior art that dictates the result. See Hansgirg v. Kemmer, 102 F.2d 212, 214 (C.C.P.A. 1939) ("Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."); Continental Can, 948 F.2d at 1269; In re Oelrich, 666 F.2d 578, 581 (C.C.P.A. 1981). "Inherency does not mean that a thing might be done, or that it might happen, ... but it must be disclosed, if inherency is claimed, that the thing will necessarily happen." In re Draeger, 150 F.2d 572, 574 (C.C.P.A. 1945) (citations omitted, emphasis added); see also Giambalvo v. Detrick, 168 F.2d 116, 120 (C.C.P.A. 1948).

It is indisputable that knob 30 formed on cover 18 of Grusin's desk organizer is not inherently capable of receiving a ring finger because it is not necessarily sized to receive a finger ring. As carefully explained to the Examiner, this is a matter of simple geometry. To put it in visual terms, Applicant attaches as Exhibit B copies of the drawing pages from Grusin that contain FIGS. 2 and 5. In Exhibit B, Applicant has drawn a hypothetical ring received over knob 30. Clearly the ring is far too oversized to be a finger ring.

Even more, Grusin teaches away from sizing his knob 30 to receive a finger ring because " the knob 30 is provided with an aperture 54 positioned immediately above the aperture 52 of the third post member 46. ... [and] ... aperture ... 54 is so dimensioned as to conveniently permit the insertion of a finger through the center of the knob 30 ..." (Col. 3, lines 44-55.) Grusin goes on to describe that "aperture ... 54 defines a ... lip ... 62 which can be grasped by the user's finger tip ..." (Id., lines 55-58.) Therefore, as

shown in FIG. 5, for the knob 30 to have an aperture 54 large enough to receive the person's finger and enough surrounding material to form a lip 62 for the person's finger to grasp, the outside dimensions of the knob necessarily are much larger than a person's finger.

The Examiner's comment that "the ring is not positively claim [sic] with the organizer" (Office Action, page 4) is misplaced. Applicant's invention is not the combination of a jewelry organizer and a finger ring; it is a jewelry organizer sized and configured for finger rings and other types of jewelry. The reference to a finger ring is a size reference. Finger rings come in various sizes. Yet, any person of ordinary skill in the design of jewelry organizers will readily understand the size ranges of finger rings without making the rings a positive limitation of the claims.

The Examiner's concern is readily answered by the case of Orthokinetics, Inc. v. Safety Travel Chairs, 806 F.2d 1565 (Fed. Cir. 1986). In that case, claim 1 defined a pediatric wheelchair and contained the limitation "wherein said front leg portion is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof." Id. at 1575. Clearly the automobile was not positively claimed with the wheelchair. The Federal Circuit held as follows:

The claims were intended to cover the use of the invention with various types of automobiles. That a particular chair on which the claims read may fit within some automobiles and not others is of no moment. The phrase "so dimensioned" is as accurate as the subject matter permits, automobiles being of various sizes. As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, § 112, 2d ¶ requires nothing more. The patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

Id. at 1576. The same is true here. Applicant is allowed to refer in the claim to other objects with which the invention is designed to be used, and need not be specific about

the dimensions of the other objects so long as "those of ordinary skill in the art realized that the dimensions could be easily obtained".

Accordingly, there is no basis for rejecting claims 8-11 as allegedly anticipated by Grusin.

(B) Claims 8-11 Are Not Anticipated By Or Obvious Over Frost

The Examiner similarly has finally rejected claims 8-11 as allegedly anticipated by or obvious over Frost, likewise asserting that "[t]he knob of Frost is inherently capable of receiving at least one finger ring over the knob ..." (Office Action, page 3.) The Examiner also has asserted that "Frost discloses ... a knob (4) protruding upwardly from the body and extending above the upper surface of the body ..." Id.

As with Grusin, there is no basis whatsoever for the Examiner's assertion that so-called "knob" 4 of Frost is inherently capable of receiving a ring finger. What the Examiner refers to as a knob in Frost is actually "a small round central embossing". (Col. 3, lines 1-2.) The only purpose of this central embossing is to support a pie crust. Since there is no suggestion in Frost of using central embossing 4 to hold a finger ring, there is no basis for asserting that the embossing necessarily is sized to receive a finger ring.

Applicant also is at a loss to understand the Examiner's characterization of the central embossing 4 of Frost as "protruding upwardly from the body and extending above the upper surface of the body ." A copy of the face page of Frost showing an enlargement of FIG. 2 is attached as Exhibit C. On Exhibit C, Applicant has indicated her understanding of the only way in which the Examiner could interpret Frost in relation to Applicant's claims. As can be seen, the "upper surface" of the body would correspond to the upper surfaces of raised embossings 5, 8 and 12 that surround the so-called "knob," central embossing 4. This must be the upper surface that the Examiner is referring to in Frost because claims 8-11 also require "at least one compartment formed in the upper surface". The "upper surface" cannot be the bottom surface of the unembossed annular

portions 10, 11, 14 or 15 or the lateral spaces 7 because they do not have any compartments formed in them; indeed, according to the Examiner, unembossed annular portions 10, 11, 14 and 15 are the compartments.

It is indisputable that the central embossing 4 is exactly the same height as the other embossings 5, 8 and 12. Therefore, Frost also does not satisfy the claim requirement of "a knob protruding upwardly from the body and extending above the upper surface." Moreover, it would be odds with the purposes of Frost's pie plate to make the central embossing 4 higher than the other embossings 5, 8 and 12, since this would render the pie plate dysfunctional.

Accordingly, there is no basis for rejecting claims 8-11 as allegedly anticipated by or obvious over Frost.

(C) Conclusion

In view of the arguments above, Appellant respectfully submits that claim 8-11 meet the requirements of patentability of 35 U.S.C. §§ 102 and 103, and patentably distinct over the references cited by the Examiner. A decision reversing the final rejection of claims 8-11 and directing the Examiner to issue a Notice of Allowance is respectfully requested.

Dated: January 5, 2004

Respectfully Submitted,

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